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PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Paul Bilibin, et al.
Application No. : 09/685,077
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT DETERMINATION OF RATABLE WEIGHT FOR MULTIPLE CARRIERS

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Examiner : Webb, Jamisue A.
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
September 21, 2006

APPEAL BRIEF

This is an appeal from a final rejection of the Examiner, dated March 13, 2006, rejecting all claims currently under examination in the case, namely Claims 1-7, 58-62, 66, 70-74, 78-79, and 83.

Applicants file this Appeal under 37 C.F.R. §41.31(a), all claims having been twice rejected.

The requisite fee set forth in 37 C.F.R. §41.20(b)(1) for filing a Notice of Appeal was presented with the filing of the Notice of Appeal and a Pre-Appeal Brief Request for Review; both of which were filed via First Class U.S. Mail on June 13, 2006 with Certificates of Mailing; both of which are acknowledged on the U.S. Patent and Trademark Office PAIR System as having been received on June 15, 2006.

The requisite fee set forth in 37 C.F.R. §41.20(b)(2) for filing this Appeal Brief is presented herewith.

In reply to the Pre-Appeal Brief Request for Review, a Notice of Panel Decision from Pre-Appeal Brief Review issued, dated July 21, 2006, indicating the application

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remained on appeal. The Notice of Panel Decision set a period of one month from the date of the Notice of Panel Decision, or two months from the date of receipt of the Notice of Appeal, whichever is greater, in which to file an Appeal Brief.

A Petition for an Extension of Time for one month and the associated fee are filed concurrently herewith under 37 C.F.R. §1.136. It is respectfully submitted that a one-month extension is appropriate because this Appeal Brief is filed within a one-month time period following the one-month period set by the Notice of Panel Decision dated July 21, 2006, because it is filed before the expiration of September 21, 2006.

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REAL PARTIES IN INTEREST (37 C.F.R. §41.37(c)(1)(i) heading)

In an Assignment, Inventors Paul Bilibin and Jinyue Liu assigned the entire right, title and interest in and to the instant application to STAMPS.COM INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 13, 2001 on Reel No. 011630 and Frame No. 0272. In a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment, STAMPS.COM INC. noticed the assignment of an undivided whole interest in common in all rights, title, and interest in and to the present application to both STAMPS.COM INC. and ISHIP INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275. Statements by both STAMPS.COM INC. and ISHIP INC. under 37 C.F.R. §3.73(b) are filed concurrently herewith.

ISHIP INC. is a fully owned subsidiary of UNITED PARCEL SERVICE OF AMERICA, INC., which is a fully owned subsidiary of UNITED PARCEL SERVICE, INC.

Accordingly, STAMPS.COM INC., ISHIP INC., UNITED PARCEL SERVICE OF AMERICA, INC., and UNITED PARCEL SERVICE, INC. are the real parties in interest in this case.

RELATED APPEALS AND INTERFERENCES (37 C.F.R. §41.37(c)(1)(ii) heading)

Applicants have not previously presented the current claim set to the Board in an Appeal Brief and there are no related appeals or interferences known to Appellants, or known to Appellants' legal representative, regarding the current claim set. However, there is an Appeal pending in the case of related U.S. Patent Application No. 09/684,861 (Applicants Bilibin, Paul et al.; Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Determining Delivery Time Schedules for Each of Multiple Carriers"; Attorney Docket No. PSTM0024/MRK; Technology Center 3600; Group/Div. 3623; Examiner Beth Van Doren). No opinion has yet been rendered in that case.

Further, there is an Appeal pending in the case of related U.S. Patent Application No. 09/680,654 (Applicants David Allison Bennett, et al., Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Featuring Shipping Rate and Delivery Schedule Comparison for

Multiple Carriers"; Attorney Docket No. PSTM0015/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Webb). No opinion has yet been rendered in that case.

Prior to filing an Appeal Brief in the case of the above-mentioned pending Appeal for Application No. 09/684,861, a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Request for Review for Application No. 09/684,861 is included in the Related Proceedings Appendix hereto.

Further, prior to filing an Appeal Brief in the case of the above-mentioned Appeal for Application No. 09/680,654 a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review for Application No. 09/680,654 is included in the Related Proceedings Appendix hereto.

Yet further, prior to filing an Appeal Brief for the present application, a Pre-Appeal Brief Request for Review of the March 13, 2006 Office Action was filed. In reply to the Pre-Appeal Brief Request for Review, a Notice of Panel Decision from Pre-Appeal Brief Review issued, dated July 21, 2006, indicating the application remained on appeal; a copy of the Notice of Panel Decision from Pre-Appeal Brief Review for the present application is included in the Related Proceedings Appendix hereto.

STATUS OF CLAIMS (37 C.F.R. §41.37(c)(1)(iii) heading)

The present application was filed on October 6, 2000, claiming priority under 37 C.F.R. §1.78(a)(4) to: U.S. Provisional Patent Application Serial No. 60/158,179, filed on October 6, 1999; U.S. Provisional Patent Application Serial No. 60/170,186, filed on December 10, 1999; U.S. Provisional Patent Application Serial No. 60/170,504, filed on December 13, 1999; U.S. Provisional Patent Application Serial No. 60/192,692, filed on March 28, 2000; U.S. Provisional Patent Application Serial No. 60/192,723, filed on March 27, 2000; U.S. Provisional Patent Application Serial No. 60/193,899, filed on March 31, 2000; and U.S. Provisional Patent Application Serial No. 60/195,748, filed on April 6, 2000.

The status of the Claims is as follows:

Allowed Claims: None

Cancelled Claims: 8-57

Withdrawn Claims: 63-65, 67-69, 75-77, and 80-82

Claims objected to: None

Rejected Claims: 1-7, 58-62, 66, 70-74, 78-79, and 83

Claims on Appeal: 1-7, 58-62, 66, 70-74, 78-79, and 83

STATUS OF AMENDMENTS (37 C.F.R. §41.37(c)(1)(iv) heading)

No amendments subsequent to the final Office Action, dated March 13, 2006, have been filed. However, it is respectfully submitted that the most recent Response to an Office Action (dated November 17, 2006) listed Claim 1, erroneously omitting the word “a” as shown within single brackets in the recitation “... (A) receive, via a first remote user client computer device of a plurality of-remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising [a] first set of parcel specifications for a first parcel” It is respectfully submitted that the previously filed amendment (the Amendment and Response, mailed August 22, 2005, to the Office Action dated May 20, 2005) did not delete the referenced word “a” from Claim 1. Therefore, the listing of Claims on Appeal in the Claims Appendix hereto lists Claim 1 showing the previously omitted word “a” as follows: “... (A) receive, via a first remote user client computer device of a plurality of remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising a first set of parcel specifications for a first parcel”

SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. §41.37(c)(1)(v) heading)

The Claims on Appeal are Claims 1-7, 58-62, 66, 70-74, 78-79, and 83. Of the Claims on appeal, Claims 1, 2, 3 and 58 are independent. It is respectfully submitted

that none of the Claims on appeal are means plus function claims.

In compliance with 37 C.F.R. § 41.37(c)(1)(v), the subject matter of the independent claims on appeal is explained below with citations to the Specification of the present application ("Specification"). Citations below to the Specification are to page and line numbers of the application as originally filed.

Independent Claims 1, 2 and 3 are directed to "[a] shipping management computer system" See e.g., Specification, Title; Specification, p. 46, lines 4-5.

In independent Claims 1, 2 and 3, the claimed shipping management computer system comprises "at least one computer device" (See, e.g., Specification, p. 18, line 6) and is programmed to, among other things, "receive, via a first remote user client computer device of a plurality of remote user client computer devices, a first input from a first user associated with the first remote user client computer device ..." (see, e.g., Specification, p. 4, lines 9-11).

Claims 1, 2 and 3 recite that the "...first input compris[es] a first set of parcel specifications for a first parcel..." (see, e.g., Specification, p. 31, lines 14-18) "... wherein the shipping management computer system is operable to associate a first user-specific origin identifier with the first user ..." (see, e.g., Specification p. 31, lines 19-24), "... wherein the first user accesses the shipping management computer system via a global communications network via the first remote user client computer device, wherein the first remote user client computer device is adapted for communication via the global communications network ..." (see, e.g., Specification, p. 4, lines 9-11), and "... wherein the first set of parcel specifications comprises a first set of physical dimensions of the first parcel and a first physical weight of the first parcel ..." (see, e.g., Specification, p. 31, lines 15-21).

In independent Claim 1, in response to the first input, the claimed shipping management computer system is further programmed to "... apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel" See, e.g.,

Specification, p. 3, line 29 – p. 4, line 8.

Similarly, in independent Claim 2, in response to a first request by the first user of the plurality of users to ship the first parcel, the claimed shipping management computer system is further programmed to "... calculate, for each respective carrier of a plurality of carriers, a respective carrier-specific dimensional weight of the first parcel according to the first set of parcel specifications for the first parcel, according to a respective set of dimensional weight calculations rules for the respective carrier, and according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel" See, e.g., Specification, p. 3, line 29 – p. 4, line 8.

Also similarly, in independent Claim 3, in response to a first request by the first user of the plurality of users to ship the first parcel, for each respective carrier of a plurality of carriers, the claimed shipping management computer system is further programmed to "... calculate a respective carrier-specific dimensional weight for the first parcel according to the first set of parcel specifications and according to a respective set of dimensional weight calculation rules for the respective carrier, wherein each respective carrier-specific dimensional weight is calculated according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel" See, e.g., Specification, p. 3, line 29 – p. 4, line 8.

In independent Claim 1, in response to the first input, the claimed shipping management computer system is further programmed to "... apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight...." See, e.g., Specification, p. 4, line 29 – p. 5, line 9; Specification, p. 58, lines 13-17.

In independent Claim 2, in response to the request by the first user to ship the

first parcel, the claimed shipping management system is further programmed to "... identify each respective carrier of the plurality of carriers that would support shipping the first parcel according to the respective carrier-specific dimensional weight of the first parcel for the respective carrier ..., and according to a respective carrier-specific dimensional weight limitation for the respective carrier; and ... apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier ..., a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight. See, e.g., Specification, p. 58, lines 13-27; Specification, p. 4, line 29 – p. 5, line 9; see also, e.g., Specification, p. 39, lines 7-12; Specification, p. 51, lines 10-13.

In independent Claim 3, in response to a first request by the first user of the plurality of users to ship the first parcel, for each respective carrier of a plurality of carriers, the claimed shipping management system is further programmed to "... calculate a respective carrier-specific dimensional weight for the first parcel according to the first set of parcel specifications and according to a respective set of dimensional weight calculation rules for the respective carrier, wherein each respective carrier-specific dimensional weight is calculated according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel" See, e.g., Specification, p. 4, lines 12-14; Specification, p. 3, line 29 – p. 4, line 8 Specification, p. 4, line 29 – p. 5, line 9.

Continuing with independent Claim 3, in response to a first request by the first user of the plurality of users to ship the first parcel, for each respective carrier of a plurality of carriers, the claimed shipping management system is further programmed to "... determine whether the respective carrier-specific dimensional weight of the first parcel ... for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier ..." See, e.g., Specification, p. 58,

lines 13-17; Specification, p. 3, lines 22-24.

Continuing with independent Claim 3, in response to a first request by the first user of the plurality of users to ship the first parcel, for each respective carrier of a plurality of carriers, the claimed shipping management system is further programmed to "... in response to determining that the respective carrier-specific dimensional weight of the first parcel ... does not exceed the corresponding respective carrier-specific dimensional weight limitation for the respective carrier, designate the respective carrier as a respective supporting carrier for shipping the first parcel" See, e.g., Specification, p. 58, lines 13-17; Specification, p. 56, lines 12-13.

Independent Claim 58 is directed to "[a] method, using a computer system, for managing shipping of a plurality of parcels shipped by any one of a plurality of carriers...". See, e.g., Specification, Title; Specification, p. 46, lines 4-5.

In independent Claim 58, the claimed method comprises "... receiving, via a first remote user client computer device of a plurality of-remote user client computer devices, a first input" See, e.g., Specification, p. 4, lines 9-11.

Independent Claim 58 recites that the "... first input compris[es] a first set of parcel specifications for a first parcel to be shipped by a first user, wherein the first set of parcel specifications comprises a first set of physical specifications about the first parcel, and wherein the first set of physical specifications about the first parcel is selected from a group consisting of: (1) a first set of physical dimensions of the first parcel and a first physical weight of the first parcel, and (2) a first type of parcel and the first physical weight of the first parcel" See, e.g., Specification, p. 33, lines 15-24.

The method of independent Claim 58 further comprises, in response to the first input, for a first carrier of a plurality of carriers, "... calculating a first carrier-specific dimensional weight according to a first set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel" See, e.g., Specification, p. 3, line 29 – p. 4, line 8.

The method of independent Claim 58 further comprises, in response to the first input, for a first carrier of a plurality of carriers, "... determining a first carrier-specific billable weight of the first parcel for the first carrier, wherein the first carrier-specific

billable weight of the first parcel for the first carrier is selected, according to a first set of carrier-specific billable weight rules, from a group consisting of: the physical weight of the first parcel, the first carrier-specific dimensional weight of the first parcel for the first carrier ..., a first carrier-specific oversize weight of the first parcel, and a first carrier-specific letter weight.” See, e.g., Specification, p. 58, lines 13-27; Specification, p. 4, line 29 – p. 5, line 9; see also, e.g., Specification, p. 39, lines 7-12; Specification, p. 51, lines 10-13.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R.

§41.37(c)(1)(vi) heading)

Issue 1 Regarding the Rejection of Claims 1-5, 58, 59, 70 and 72 Under Section 102(b) as Being Anticipated by Nicholls

Claims 1-5, 58, 59, 70 and 72 were rejected in Topic Number 5 (p. 2) of the final Office Action under 35 U.S.C. §102(b) as being anticipated by Nicholls et al. (U. S. Patent No. 5,485,369; “Nicholls”).

Issue 1a Regarding the Rejection of Independent Claims 1, 2 and 3, and Claims 4 and 5 Which are Dependent on Claim 3, Under 35 U.S.C. §102(b) as Being Anticipated by Nicholls.

Issue 1b Regarding the Rejection of Independent Claim 58, and Claim 70 Which is Dependent on Claim 58, Under 35 U.S.C. §102(b) as Being Anticipated by Nicholls.

Issue 1c Regarding the Rejection of Claims 59 and 72 Which are Dependent on Claim 58, Under 35 U.S.C. §102(b) as Being Anticipated by Nicholls.

Issue 2 Regarding the Rejection of Claims 7, 71, 73, 78 and 83 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Kara.

Claims 7, 71, 73, 78, and 83 were rejected in Topic Number 9 (p. 4) of the final Office Action under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Kara et al. (U.S. Patent No. 6,233,568; "Kara").

Issue 3 Regarding the Rejection of Claims 6, and 60-61 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Barns-Slavin.

Claims 6, and 60-61 were rejected in Topic No. 11 (p. 4) of the final Office Action under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Barns-Slavin et al. (U.S. Patent No. 5,995,950; "Barns-Slavin").

Issue 4 Regarding the Rejection of Claims 62, 66, 74 and 79 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Jensen.

Claims 62, 66, 74, and 79 were rejected in Topic Number 13 (p. 5) of the final Office Action under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Jensen (U.S. Patent No. 5,331,118 ("Jensen").

Issue 4a Regarding the Rejection of Claims 74 and 79 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Jensen.

Issue 4b Regarding the Rejection of Claims 62 and 66 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Jensen.

A copy of each of Nicholls, Kara, Barns-Slavin, and Jensen are included in the Evidence Appendix hereto.

ARGUMENT (37 C.F.R. §41.37(c)(1)(vii) heading)

For the reasons described in more detail below, it is respectfully submitted that Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are not anticipated by, and are non-obvious over, Nicholls, Kara, Barns-Slavin and Jensen, whether considered alone or in combination with any other reference(s) of record. Accordingly, it is respectfully

requested that the rejections of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 be reversed, and that the Claims on appeal be allowed.

Issue 1 Argument Regarding the Rejection of Claims 1-5, 58, 59, 70 and 72 Under Section 102(b) as Being Anticipated by Nicholls

Issue 1a Argument Regarding the Rejection of Independent Claims 1, 2 and 3, and Claims 4 and 5 Which are Dependent on Claim 3, under 35 U.S.C. §102(b) as Being Anticipated by Nicholls: There is No Disclosure in Nicholls that Nicholls Calculates a Dimensional Weight or Populates a Dimensional Weight Field, and Even Assuming for the Sake of Argument That Nicholls Does Disclose Populating a Dimensional Weight Field, There is No Disclosure, Teaching or Suggestion that Nicholls Would Do So "In Response to an Input" of Parcel Specifications, or "For Each Respective Carrier of a Plurality of Carriers" as Recited in Independent Claims 1, 2 and 3 (37 C.F.R. §41.37(c)(1)(vii) subheading)

Independent Claims 1, 2 and 3 are all directed to a shipping management computer system that is programmed to, among other things, calculate a dimensional weight for each respective carrier of a plurality of carriers according to each respective carrier's dimensional weight calculation rules. The following recitation of Claim 1 is exemplary:

... in response to [a] first input [comprising a first set of parcel specifications for a first parcel]: ... apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel

As compared to the above-recited limitations of independent Claim 1 (and as compared to similar recitations by independent Claims 2 and 3), it is respectfully submitted that there is no disclosure in Nicholls that Nicholls calculates a dimensional weight, much less that it calculates a dimensional weight for *each carrier* of a plurality of

carriers, or that it does so by applying a respective set of carrier-specific dimensional weight calculation rules.

As compared to, and in lieu of, a disclosure in Nicholls of a calculation of dimensional weight, the Office Action cites columns 21 and 22, line 65 of Nicholls as supporting the proposition that "...Nicholls ... determines a dimensional weight" Office Action, Topic No. 6, p. 2. The cited columns list many entries in a "Table II" of Nicholls; the cited entry at line 65 in "Table II" is identified as an "I/O Token" named "DIMWT" and is described as "dimensional weight". Nicholls, cols. 21-22, line 65. Other than the listing of the "DIMWT" I/O Token in Table II of Nicholls, it is respectfully submitted that there is no further mention of the "DIMWT" I/O Token in Nicholls.

For the reasons described further below, it is respectfully submitted that the appearance of the cited "DIMWT" I/O Token entry in "Table II" of Nicholls does not constitute a disclosure that "DIMWT" is a value that has been "calculated" by Nicholls as recited by independent Claims 1, 2 and 3, or that the I/O Token named "DIMWT" is necessarily even populated by Nicholls.

Nicholls explains that "[t]he presently preferred embodiment uses a tokenized message passing scheme in which all data is passed back and forth between client and server as ordered pairs of tokens and associated data values.... Table II ...[presents] a sample listing of tokens ..." Nicholls, col. 13, line 7-13. Nicholls also explains that "[i]n order to allow the client server logistics management system to communicate with the outside world, e.g. with external data bases or other application programs, the external processing manager is provided." Nicholls, col. 13, lines 52-55.

In view of the above-outlined disclosure of Nicholls, it is respectfully submitted that the presence of an entry in Table II of Nicholls is therefore merely a sample listing of a token and does not constitute a disclosure that the entry is necessarily populated by Nicholls.

Further, even assuming for the sake of argument that Nicholls, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that Nicholls would do so "for each respective carrier of a plurality of carriers" as recited in one way or another by independent Claims 1, 2 and 3, or that it would do so by

“...apply[ing] a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carrier ...” as recited by Claim 1, or “... according to a respective set of dimensional weight calculations rules for [each respective carrier of a plurality of carriers] ...” as recited by Claim 2, or “... according to a respective set of dimensional weight calculation rules for the respective carrier [for each respective carrier of a plurality of carriers] ...” as recited by Claim 3. Rather, it is respectfully submitted that there is only a single “DIMWT” entry in Table II of Nicholls. See Nicholls, col. 15, line 6 – col. 27, line 27.

Importantly, the single “DIMWT” entry in the Nicholls Table II follows a long list of per-package entries that are typically customer/user-specified input for a particular package, including, among others, e.g., weight, package length, package width, package height, recipient ID, recipient contact name, recipient company name, etc. (see Nicholls, cols. 21-22). Therefore, even assuming that Nicholls, at some point, populates a “DIMWT” I/O Token, the single “DIMWT” I/O Token entry in Table II of Nicholls appears to indicate that there would be only a single “DIMWT” I/O Token entry, as compared to a carrier-specific entry “... for each respective carrier of a plurality of carriers ...” as recited by independent Claims 1, 2 and 3.

It is respectfully asserted that the limitations recited by independent Claims 1, 2 and 3 that a dimensional weight is calculated “... for each respective carrier of a plurality of carriers ...” are patentably distinct from a single “DIMWT” I/O Token entry as shown in Table II of Nicholls. For example, it is respectfully asserted that various embodiments of the limitations recited by independent Claims 1, 2 and 3 would provide carrier-specific dimensional weights that reflect differences between the respective carriers’ dimensional weight calculation rules. For example, these Claims include the limitations that a dimensional weight is calculated “... for each respective carrier of a plurality of carriers ...” and that such a carrier-specific dimensional weight is calculated by applying, or according to, carrier-specific dimensional weight calculation rules. In comparison, a single Nicholls “DIMWT” I/O Token entry would not reflect different carrier-specific dimensional weight calculation rules.

Yet further, even assuming that Nicholls, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that Nicholls would do so "... in response to [a] first input [comprising a first set of parcel specifications for a first parcel]..." as recited by independent Claims 1, 2 and 3. Rather, it is respectfully submitted that other entries in Table II of Nicholls, such as, for example, the I/O Token entry labeled "TRACKNBR" following the "DIMWT" entry (described as "tracking number/COD tracking"), and the I/O Token entry named "CODRETTTRK" that follows the "TRACKNBR" entry (described as "COD return tracking number"), indicate *post-shipment-ordering*, and possibly carrier-supplied, fields, not pre-shipment-order calculations or determinations provided in response to an input of parcel specifications.

It is true that Nicholls professes to "... encode [in the rate servers] the knowledge required to answer questions such as how to calculate shipment rates" Nicholls, col. 5, lines 34-36. It is also true that Nicholls also states that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier." Nicholls, col. 2, lines 17-19. However, it is respectfully asserted that there is nothing inherent in a profession to "... encode the knowledge required ... to calculate shipment rates" that shipment rate calculations would necessarily include any particular detail of a shipping rate calculation such as a calculation of dimensional weight according to a carrier-specific dimensional weight calculation rule. Yet further, it is respectfully asserted that there is nothing inherent in the statement that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier..." that the rate servers are necessarily programmed to include any particular detail of a shipping rate calculation such as a calculation of dimensional weight according to a carrier-specific dimensional weight calculation rule. Still further, it is respectfully asserted that the appearance of only a single "DIMWT" I/O Token entry in the Nicholls' Table II, is evidence that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules.

Because Nicholls does not expressly or inherently disclose calculating a dimensional weight, or calculating a dimensional weight in response to an input of parcel specifications, or calculating a dimensional weight for each carrier of a plurality of carriers, it is respectfully asserted, therefore, that Nicholls does not expressly or inherently disclose all of the limitations of independent Claims 1, 2 or 3. Accordingly, it is respectfully asserted that Nicholls does not anticipate independent Claims 1, 2 or 3. Cf., e.g., Metabolite Lab., Inc. v. Laboratory Corp. of Am. Holdings, 370 F.3d 1354, 1367, 71 U.S.P.Q.2d 1081, 1090 (Fed. Cir. 2004) ("A prior art reference [only] anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim." EMI Group N. Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed Cir. 2001) (citation omitted).").

Conclusion Regarding Issue 1a Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claims 1, 2 and 3, and Claims 4 and 5 which are dependent on Claim 3, under 35 U.S.C. §102(b), the rejections of all of which rely on Nicholls, be reversed. Further, for the reasons described above, it is respectfully submitted that independent Claims 1, 2, and 3 are patentable over the references of record. Yet further, it is therefore respectfully submitted that the Claims 6, 7, 74, 78, 79 and 83 that are dependent in one way or another on one of independent Claims 1, 2, or 3, as the case may be, are also patentable over the references of record.

Issue 1b Argument Regarding the Rejection of Independent Claim 58, and Claim 70 which is dependent on Claim 58, under 35 U.S.C. §102(b) as Being Anticipated by Nicholls: There is No Disclosure in Nicholls that Nicholls Calculates a Dimensional Weight or Populates a Dimensional Weight Field, and Even Assuming For the Sake of Argument That Nicholls Does Disclose Populating a Dimensional Weight Field, There is No Disclosure, Teaching or Suggestion that Nicholls Would Do So “In Response to an Input” of Parcel Specifications as Recited in Independent Claim 58 (37 C.F.R. §41.37(c)(1)(vii) subheading)

Independent Claim 58 is directed to a method, using a computer system, for managing shipping of a plurality of parcels shipped by any one of a plurality of carriers. Independent Claim 58 recites that the method comprises, among other things:

... in response to the first input [comprising a first set of parcel specifications for a first parcel to be shipped by a first user], for a first carrier of a plurality of carriers:
... calculating a first carrier-specific dimensional weight according to a first set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel

As compared to the above-recited limitations of independent Claim 58, it is respectfully submitted that there is no disclosure in Nicholls that Nicholls calculates a dimensional weight, or that it even *populates* a dimensional weight field.

As compared to, and in lieu of, a disclosure in Nicholls of a calculation of dimensional weight, the Office Action cites columns 21 and 22, line 65 of Nicholls as supporting the proposition that "...Nicholls ... determines a dimensional weight" Office Action, Topic No. 6, p. 2. The cited columns list many entries in a "Table II" of Nicholls; the cited entry at line 65 in "Table II" is identified as an "I/O Token" named "DIMWT" and is described as "dimensional weight". Nicholls, cols. 21-22, line 65. Other than the listing of the "DIMWT" I/O Token in Table II of Nicholls, it is respectfully submitted that there is no further mention of the "DIMWT" I/O Token in Nicholls.

For the reasons described further below, it is respectfully submitted that the appearance of the cited "DIMWT" I/O Token entry in "Table II" of Nicholls does not constitute a disclosure that "DIMWT" is a value that has been "calculated" by Nicholls as recited by independent Claim 58, or that the I/O Token named "DIMWT" is necessarily even *populated* by Nicholls.

Nicholls explains that "[t]he presently preferred embodiment uses a tokenized message passing scheme in which all data is passed back and forth between client and server as ordered pairs of tokens and associated data values.... Table II ...[presents] a sample listing of tokens ..." Nicholls, col. 13, lines 7-13. Nicholls also explains that "[i]n order to allow the client server logistics management system to communicate with the outside world, e.g. with external data bases or other application programs, the external processing manager is provided." Nicholls, col. 13, lines 52-55.

In view of the above-outlined disclosure of Nicholls, it is respectfully submitted that the presence of an entry in Table II of Nicholls is therefore merely a sample listing of a token and does not constitute a disclosure that the entry is necessarily populated by Nicholls.

Further, even assuming for the sake of argument that Nicholls, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that Nicholls would do so "... in response to the first input [comprising a first set of parcel specifications for a first parcel to be shipped by a first user] ..." as recited in independent Claim 58.

Importantly, the single "DIMWT" entry in the Nicholls Table II follows a long list of per-package entries that are typically customer/user-specified input for a particular package, including, among others, e.g., weight, package length, package width, package height, recipient ID, recipient contact name, recipient company name, etc. (see Nicholls, cols. 21-22).

Further, it is respectfully submitted that other entries in Table II of Nicholls, such as, for example, the I/O Token entry labeled "TRACKNBR" that immediately follows (Nicholls, cols. 21-22, line 66) the "DIMWT" entry (described as "tracking number/COD tracking"), and the I/O Token entry named "CODRETTRK" (Nicholls, cols. 23-24, line 7)

that follows the "TRACKNBR" entry (described as "COD return tracking number"), are typically *post-shipment-ordering*, and possibly carrier-supplied, *fields*, as compared to pre-shipment-ordering calculations or determinations provided in response to an input of parcel specifications.

Yet further, even assuming that Nicholls, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that Nicholls would do so "... according to a first set of carrier-specific dimensional weight calculation rules ..." as recited by Claim 58. It is respectfully asserted that, as compared to Nicholls, various embodiments of a carrier-specific dimensional weight as claimed by Claim 59 would be calculated "... according to a first set of carrier-specific dimensional weight calculation rules ..." and would provide a carrier-specific dimensional weight that reflects the respective carrier's dimensional weight calculation rules. In comparison, it is respectfully asserted that a single "DIMWT" I/O Token entry would not reflect a respective carrier's carrier-specific dimensional weight calculation rules.

As previously mentioned above, it is true that Nicholls professes to "... encode [in the rate servers] the knowledge required to answer questions such as how to calculate shipment rates" Nicholls, col. 5, lines 34-36. It is also true that Nicholls also states that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier." Nicholls, col. 2, lines 17-19. However, it is respectfully asserted that there is nothing inherent in a profession to "... encode the knowledge required ... to calculate shipment rates" or in the statement that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier...", that the rate servers are necessarily programmed to include any particular detail of a shipping rate calculation such as a calculation of dimensional weight according to a carrier-specific dimensional weight calculation rule. Still further, it is respectfully asserted that the appearance of only a single "DIMWT" I/O Token entry in the Nicholls' Table II is evidence that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules.

Because Nicholls does not expressly or inherently disclose calculating a dimensional weight, or calculating a dimensional weight in response to an input of parcel specifications, or calculating a carrier-specific dimensional weight, it is respectfully asserted, therefore, that Nicholls does not expressly or inherently disclose all of the limitations of independent Claim 58. Accordingly, it is respectfully asserted that Nicholls does not anticipate independent Claim 58 or Claim 70 which is dependent on independent Claim 58. Cf., e.g., Metabolite Lab., Inc. v. Laboratory Corp. of Am. Holdings, 370 F.3d 1354, 1367, 71 U.S.P.Q.2d 1081, 1090 (Fed. Cir. 2004) ("A prior art reference [only] anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim.' EMI Group N. Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed Cir. 2001) (citation omitted).").

Conclusion Regarding Issue 1b Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claim 58, and Claim 70 which is dependent on Claim 58, under 35 U.S.C. §102(b), the rejections of all of which rely on Nicholls, be reversed. Further, for the reasons described above, it is respectfully submitted that independent Claim 58 is patentable over the references of record. Yet further, it is therefore respectfully submitted that Claim 70 that is dependent on independent Claim 58, is also patentable over the references of record.

Issue 1c Argument Regarding the Rejection of Claims 59 and 72 Which are Ultimately Dependent on Claim 58, under 35 U.S.C. §102(b) as Being Anticipated by Nicholls: There is No Disclosure in Nicholls that Nicholls Calculates a Dimensional Weight or Populates a Dimensional Weight Field, and Even Assuming for the Sake of Argument That Nicholls Does Disclose Populating a Dimensional Weight Field, There is No Disclosure, Teaching or Suggestion that Nicholls Would Do So “In Response to an Input” of Parcel Specifications, or that Nicholls Would Do So For More Than One Carrier Such as is the Subject Matter of Claims 59 and 72 (37 C.F.R. §41.37(c)(1)(vii) subheading)

Because Claims 59 and 72 ultimately depend on Claim 58, for the reasons given above with respect to independent Claim 58 why Claim 58 is patentable over Nicholls, it is respectfully submitted that Claims 59 and 72 are therefore also patentable over Nicholls.

Further, Claims 59 and 72 are both directed to calculating a dimensional weight for more than one carrier. Claim 59, for example, recites:

- (C) in response to the first input, for a second carrier of the plurality of carriers:
 - (1) calculating a second carrier-specific dimensional weight according to a second set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel ...

Claim 72 depends on Claim 59.

As previously mentioned above, even assuming for the sake of argument that Nicholls, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that Nicholls would do so for "... a second carrier of the plurality of carriers ..." as recited by Claim 59. Rather, as previously mentioned above, it is respectfully submitted that there is only a single "DIMWT" entry in Table II of Nicholls. See Nicholls, col. 15, line 6 – col. 27, line 27.

Importantly, the single "DIMWT" entry in the Nicholls Table II follows a long list of per-package entries that are typically customer/user-specified input for a particular package, including, among others, e.g., weight, package length, package width, package height, recipient ID, recipient contact name, recipient company name, etc. (see

Nicholls, cols. 21-22). Therefore, even assuming that Nicholls, at some point, populates a "DIMWT" I/O Token, the single "DIMWT" I/O Token entry in Table II of Nicholls appears to indicate that there would be only a single "DIMWT" I/O Token entry, as compared to an entry for "... a second carrier of the plurality of carriers ..." as recited by Claim 59.

It is respectfully submitted that the limitations recited by Claim 59 that a dimensional weight is calculated for "... a second carrier of the plurality of carriers ..." as recited by Claim 59 is patentably distinct from a single "DIMWT" I/O Token entry as shown in Table II of Nicholls.

Further, as previously mentioned above, even though Nicholls professes to "... encode [in the rate servers] the knowledge required to answer questions such as how to calculate shipment rates ..." (Nicholls, col. 5, lines 34-36), and even though Nicholls also states that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier" (Nicholls, col. 2, lines 17-19), it is respectfully asserted that there is nothing inherent in the Nicholls disclosure that shipment rate calculations would necessarily include any particular detail of a shipping rate calculation such as a calculation of dimensional weight according to a carrier-specific dimensional weight calculation rule. Still further, it is respectfully asserted that the appearance of only a single "DIMWT" I/O Token entry in the Nicholls' Table II is evidence that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules.

Because Nicholls does not expressly or inherently disclose calculating a dimensional weight, or calculating a dimensional weight in response to an input of parcel specifications, or calculating a dimensional weight for more than one carrier of a plurality of carriers, it is respectfully asserted, therefore, that Nicholls does not expressly or inherently disclose all of the limitations of independent Claims 59 or 72. Accordingly, it is respectfully asserted that Nicholls does not anticipate Claims 59 or 72. Cf., e.g., Metabolite Lab., Inc. v. Laboratory Corp. of Am. Holdings, 370 F.3d 1354, 1367, 71 U.S.P.Q.2d 1081, 1090 (Fed. Cir. 2004) ("A prior art reference [only] anticipates a

patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim.’ EMI Group N. Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed Cir. 2001) (citation omitted).”).

Conclusion Regarding Issue 1c Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claims 59 and 72 under 35 U.S.C. §102(b), the rejections of all of which rely on Nicholls, be reversed. Further, for the reasons described above, it is respectfully submitted that dependent Claims 59 and 72 are patentable over the references of record.

Issue 2 Argument Regarding the Rejection of Claims 7, 71, 73, 78 and 83 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Kara: There is No Disclosure in Kara of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier (37 C.F.R. §41.37(c)(1)(vii) subheading)

Because Claim 78 ultimately depends on independent Claim 1, because Claim 83 ultimately depends on independent Claim 2, because Claim 7 ultimately depends on independent Claim 3, and because Claims 71 and 73 ultimately depend on independent Claim 58, for the reasons given above with respect to independent Claims 1, 2, 3 and 58 why those Claims are patentable over Nicholls, it is respectfully submitted that Claims 7, 71, 73, 78 and 83 are therefore also patentable over Nicholls.

Further, it is respectfully submitted that each of Claims 7, 71, 73, 78 and 83 is either directed to, or depends on a Claim that is directed to, calculating a shipping rate for each delivery service offered by a carrier, or a plurality of carriers, as the case may be. The following limitations of Claim 5, on which Claim 7 depends, are exemplary:

(D) for each respective delivery service of a plurality of delivery services offered by each respective supporting carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel.

Similarly, the limitations of Claim 70 provide:

for each respective delivery service of a plurality of delivery services offered by the first carrier: calculating a respective service-specific shipping rate for shipping the first parcel

In rejecting Claims 7, 71, 73, 78 and 83, the Office Action states that “Nicholls ... discloses the use of calculating rates for multiple carriers, but discloses the automatic selection of the carrier, and fails to disclose displaying all of the rates to the user.”

Office Action, Topic 10, p. 4. The Office Action rejects Claims 7, 71, 73, 78 and 83 on the grounds that “Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38).” Office Action, Topic 10, p. 4.

It is respectfully asserted that, as compared to the limitations of Claims 7, 71, 73, 78 and 83 (either specifically recited in those Claims, or in Claims on which those Claims ultimately depend) regarding the calculation of a shipping rate for each delivery service offered by one or more carriers, Kara discloses a system that requires that a user first pre-select a class and/or delivery “urgency”. FIG. 7 of Kara depicts process element 712 that is labeled “Class/Urgency” and that contains the description “Select from different choices: first, third, fourth, bulk rate, priority mail, air mail, same day, overnight, next day, 2 days, 3 days”. FIG. 8 of Kara depicts a display interface with a box 802 providing fields for Weight (Pounds and Ounces), Zone, Class, and a choice of Domestic or International. FIG. 8 of Kara also depicts a box 807, labeled as “Urgency” and containing the choices of “Same day”, “Overnight”, “Next day”, “2 Days”, “3 Days”, and “Immaterial”. The specification of Kara explains that, “[i]n step 712, the user selects the class and/or urgency of the item from the choices shown in box 802 and 807. It shall be appreciated that ones of the selections of class and urgency may substantially overlap and, therefore, selection of such an option from one of boxes 802 or 807 may also make a corresponding selection in the other one of boxes 802 or 807.” Kara, col. 21, lines 1-7.

Kara discloses that “class and urgency information may be different for each of the shipping service providers and, accordingly, selection of a particular class[] or urgency criteria may be based at least in part on the particular shipping service

provider(s) for which the user wishes the ... program to calculate the necessary postage.... Alternatively, the class and urgency information may be presented for selection generically, as shown in FIG. 8, and the ... program operate to determine the corresponding fees for each of the particular shipping service providers automatically.”

Kara, col. 21, lines 8-20.

Whether the class and urgency information available for selection by the user is presented “generically” (as depicted in FIG. 8 of Kara), or is available for “selection ... based ... on the particular shipping service provider”, Kara explains that, only after a selection of class and/or urgency is made are fees calculated and displayed.

In order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship the piece of mail or other item, the E-STAMP program may calculate the fees associated with a plurality of the available shipping service providers. Accordingly, the user may select shipping service providers of interest (not shown) in order to allow the E-STAMP program to determine the fees for only those shipping service providers. Thereafter, the E-STAMP program may calculate and display fees associated with shipping the item via the selected shipping service providers according to the desired shipping and/or delivery parameters, i.e., class, urgency, etc. Where a selected shipping service provider does not provide a desired shipping and/or delivery parameter, the E-STAMP program may indicate such and provide the fees for a service offered by that particular shipping service provider most near that desired by the user.

However, in the preferred embodiment, the E-STAMP program automatically calculates the fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters. Additionally, the E-STAMP program may indicate other ones of the shipping service providers which do not provide a desired shipping and/or delivery parameter and provide the fees for a service offered by that particular shipping service provider most near that desired by the user, as well as indicate how their service differs from that desired.

Kara, col. 22, lines 20 – 48.

FIG. 8 of Kara depicts box 808 which is labeled “Selection & Comparison”. In box 808 of FIG. 8 of Kara, the carriers “US Post”, “Federal Express”, “DHL”, “UPS”, “Purolator”, and “Emery” are listed. To the left of each carrier is a box, with which to select one of the carriers. See Kara, col. 22, lines 53-54 (“...the user selects a particular shipping service provider, such as by checking a box associated therewith

(shown in box 808) ..."). To the right of each carrier (shipping service provider) in box 808 is a dollar field for display of a shipping rate. Kara, FIG. 8. Importantly, only one dollar field is indicated per carrier.

Therefore, as clarified from the position stated in the Office Action that "Kara discloses ... calculate[ing] shipping rates ... for multiple services ..." (Office Action, Topic 10, p. 4), it is respectfully submitted that Kara discloses calculating and displaying only a single shipping rate per carrier (shipping service provider) at a time based on a user's pre-selection of either a generic class/urgency for all providers, or based on a user's pre-selection of a carrier-specific class/urgency for each provider.

Accordingly, it is respectfully asserted that Kara does not disclose all of the limitations of Claims 7, 71, 73, 78 and 83 (or of all of the Claims on which those Claims ultimately depend).

Further, it is respectfully submitted that each of Claims 7, 71, 73, 78 and 83 (or Claims on which those Claims depend) recite limitations of an online comparison display of each shipping rate calculated for each delivery service of one or more carriers. The following limitations of Claim 83 are exemplary:

(E) generate an online comparison display to a first display monitor operable with the first remote user client computer device, wherein said online comparison display comprises an indication of each respective service-specific shipping rate for shipping the first parcel calculated in Step (D).

As compared to, e.g., the above-recited limitations of Claim 83 (*cf. also, e.g.,* limitations of Claims 7, 71, 73, and 78), in order to obtain a comparison of rates using Kara, it is respectfully submitted that a user would need to first indicate a first "urgency", e.g., "Overnight" on FIG. 8 of Kara, so that the Kara system would, according to the specification of Kara (e.g., Kara, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via the indicated first "urgency". Once the system had calculated the rates, the user could, for example, write the rates, or print the screen showing the rates, for the first indicated "urgency".

Next, in order to obtain a comparison of rates using Kara, a user of Kara would need to indicate a second "urgency", e.g., "Next day" on FIG. 8 of Kara, so that the Kara

system would, according to the specification of Kara (e.g., Kara, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via the indicated second "urgency". Once the system had calculated the rates, the user could, for example, write the rates, or print the screen showing the rates, for the second indicated "urgency".

The user would need to continue to indicate each successive "urgency", to cause the Kara system to calculate rates for each successive indicated urgency for each shipping service provider; the Kara user would need to then write the rates, or print the screen showing the rates, for each successive "urgency".

Only when the Kara user had completed the process of indicating each successive "urgency", obtaining the rates, and writing the rates or printing the screens, would the Kara user have a comparison of rates. However, even after having gone through such a process, the Kara user would have only a paper record of a comparison of rates, and would still not have "... an online comparison display ..." (e.g., as claimed in Claims 7, 71, 73, 78, and 83).

Accordingly, it is respectfully asserted that Kara does not disclose all of the limitations of Claims 7, 71, 73, 78 and 83 (or of the Claims on which those Claims depend).

Conclusion Regarding Issue 2 Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claims 7, 71, 73, 78 and 83 under 35 U.S.C. §103(a) be reversed. Further, for the reasons described above, it is respectfully submitted that Claims 7, 71, 73, 78 and 83 are patentable over the references of record.

Issue 3 Argument Regarding the Rejection of Claims 6, and 60-61 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Barns-Slavin:
There is No Disclosure in Barns-Slavin of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier, or of Comparing a Dimensional Weight of a Particular Parcel to a Dimensional Weight Limitation for a Particular Carrier (37 C.F.R. §41.37(c)(1)(vii) subheading)

Because Claim 6 ultimately depends on independent Claim 3, and because Claims 60 and 61 ultimately depend on Claim 58, for the reasons given above with respect to independent Claims 3 and 58 why those Claims are patentable over Nicholls, it is respectfully submitted that Claims 6 and 60-61 are therefore also patentable over Nicholls.

Further, it is respectfully submitted that combining Barns-Slavin with Nicholls still does not disclose, anticipate, teach or suggest, the above-cited limitations of Claims 3 and 4 on which Claim 6 ultimately depends (e.g., "...apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers ..."), because, similar to Kara, Barns-Slavin discloses a pre-selection of a carrier. See, e.g., Barns-Slavin, col. 1, lines 8-10 ("... carrier management system for enabling a user to determine the shipping charges for shipping of parcels by a *selected* carrier." (emphasis added)).

The Office Action states that "Nicholls ... fails to disclose determining if the dimensional weight exceeds the carrier's dimensional weight limitations and calculating the rates for carriers, which are capable of shipping the weight of the package (Column 1, lines 34-42)." Office Action, Topic No. 12, pp. 4-5. In the Office Action, Claims 6, and 60-61 are rejected on the grounds that "[i]t would have been obvious ... to modify Nicholls, to include the carrier's weight restriction in the rate calculations, in order to factor in the carrier's capability to ship the items, into the calculated rate. See Barns-Slavin, Column 1." Office Action, Topic No. 12, p. 5.

It is respectfully submitted that the cited Column 1 of Barns-Slavin discloses "... a capability for determining discounted shipping charges for groups of parcels to be shipped ... where the group of parcels met certain predetermined requirements such as,

total weight of the group or average weight of the group.” Barns-Slavin, col. 1, lines 34-38.

As compared to “... determining discounted shipping charges ...” for a predetermined requirement as to a total weight of a group of parcels as disclosed in Barns-Slavin, Claim 6 recites:

(2) determine whether the respective carrier-specific dimensional weight of the second parcel ... for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier;

Claim 3, on which Claim 6 ultimately depends, recites:

(2) determine whether the respective carrier-specific dimensional weight of the first parcel ... for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier;

As further compared to “... determining discounted shipping charges ...” for a predetermined requirement as to a total weight of a group of parcels as disclosed in Barns-Slavin, Claim 3 is directed to “... a first request by the first user of the plurality of users to ship the first parcel ...”; Claim 6 is directed to “... a second request by the second user of the plurality of users to ship the second parcel ...”.

Similarly, as compared to “... determining discounted shipping charges ...” for a predetermined requirement as to a total weight of a group of parcels as disclosed in Barns-Slavin, Claims 60 and 61 recite:

... determining whether the first carrier-specific dimensional weight of the first parcel ... for the first carrier exceeds a corresponding first carrier-specific dimensional weight limitation for the first carrier

It is respectfully asserted that determining whether a dimensional weight of a particular parcel exceeds a carrier-specific dimensional weight limitation as claimed in Claims 3, 6, 60 and 61, is patentably distinct from determining whether a “... group of parcels met certain predetermined requirements such as, total weight of the group or average weight of the group ...” for the purpose of “... determining discounted shipping charges ...” as disclosed in Barns-Slavin.

Conclusion Regarding Issue 3 Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejection of Claims 6 and 60-61 under 35 U.S.C. §103(a) be reversed. Further, for the reasons described above, it is respectfully asserted that Claims 6 and 60-61 are patentable over the references of record.

Issue 4 Argument Regarding the Rejection of Claims 62, 66, 74 and 79 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Jensen.

Issue 4a Argument Regarding the Rejection of Claims 74 and 79 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Jensen:
There is No Disclosure in Barns-Slavin of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier or of Comparing a Dimensional Weight of a Particular Parcel to a Dimensional Weight Limitation for a Particular Carrier (37 C.F.R. §41.37(c)(1)(vii) subheading)

Because Claim 74 ultimately depends on independent Claim 1, and because Claim 79 ultimately depends on independent Claim 2, for the reasons given above with respect to independent Claims 1 and 2 why those Claims are patentable over Nicholls, it is respectfully submitted that Claims 74 and 79 are therefore also patentable over Nicholls.

Jensen is directed to "an integrated measuring system on a conveyor belt system capable of electronically acquiring information about a package's dimensions ..." and "... the actual package weight ..." for "... transmitting ... to electronic data processing units for calculation of the packages dimensional volume for use in other calculations such as determination of its freight cost ...". Jensen, col. 2, lines 20 - 31.

It is respectfully submitted that there is no disclosure in Jensen that Jensen, or the system(s) to which Jensen transmits, "... appl[ies] a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific

dimensional weight ..." as recited, e.g., in Claim 1 (emphasis added) on which Claim 74 depends.

Further, it is respectfully submitted that there is no disclosure in Jensen that Jensen, or the system(s) to which Jensen transmits, "...calculate[s], for each respective carrier of a plurality of carriers, a respective carrier-specific dimensional weight of the first parcel ..." as recited in Claim 2 on which Claim 79 depends (emphasis added).

Therefore, it is respectfully asserted that Jensen, whether considered alone or in combination with Nicholls or any other reference of record, does not disclose, anticipate, teach or suggest all of the limitations of Claims 74 and 79, or of the Claims on which Claims 74 and 79 depend.

Conclusion Regarding Issue 4a Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claims 74 and 79 under 35 U.S.C. §103(a) be reversed. Further, for the reasons described above, it is respectfully asserted that Claims 74 and 79 are patentable over the references of record.

Issue 4b Argument Regarding the Rejection of Claims 62 and 66 Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of Jensen (37 C.F.R. §41.37(c)(1)(vii) subheading)

Because Claims 62 and 66 ultimately depend on independent Claim 58, for the reasons given above with respect to independent Claim 58 why Claim 58 is patentable over Nicholls, it is respectfully submitted that Claims 62 and 66 are therefore also patentable over Nicholls.

Further, because Claim 66 depends on Claim 59, for the reasons given above with respect to Claim 59 why Claim 59 is patentable over Nicholls, it is respectfully submitted that Claim 66 is therefore also patentable over Nicholls.

Conclusion Regarding Issue 4b Argument

Accordingly, in view of the above-given reasons, it is respectfully requested that the rejections of Claims 62 and 66 under 35 U.S.C. §103(a) be reversed. Further, for the reasons described above, it is respectfully asserted that Claims 62 and 66 are patentable over the references of record.

ARGUMENT CONCLUSION

Accordingly, for the above-given reasons and authorities, it is respectfully requested that the rejections of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 be reversed. Further, for the reasons and authorities described above, it is respectfully asserted that Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are patentable over the references of record and that the application is in condition for allowance.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi 09/21/06
Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856

CLAIMS APPENDIX (37 C.F.R. §41.37(c)(1)(viii) heading)

(Double-Spaced as required by MPEP §1205.02)

THE CLAIMS ON APPEAL ARE THE PENDING CLAIMS AFTER THE AMENDMENT AND RESPONSE FILED DECEMBER 13, 2005 IN RESPONSE TO THE OFFICE ACTION DATED NOVEMBER 17, 2005, AND ARE AS FOLLOWS:

1. A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

(A) receive, via a first remote user client computer device of a plurality of-remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising a first set of parcel specifications for a first parcel, wherein the shipping management computer system is operable to associate a first user-specific origin identifier with the first user, wherein the first user accesses the shipping management computer system via a global communications network via the first remote user client computer device, wherein the first remote user client computer device is adapted for communication via the global communications network, and wherein the first set of parcel specifications comprises a first set of physical dimensions of the first parcel and a first physical weight of the first parcel; and

(B) in response to the first input:

(1) apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel; and

(2) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

2. A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

(A) receive, via a first remote -user client computer device of a plurality of-remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising a first set of parcel specifications for a first parcel to be shipped by the first user, wherein the shipping management computer system is operable to associate a first user-specific origin

identifier with the first user, wherein the first user accesses the shipping management computer system via a global communications network via the first remote user client computer device, wherein the first remote user client computer device is adapted for communication via the global communications network, and wherein the first set of parcel specifications comprises a first set of physical dimensions of the first parcel and a first physical weight of the first parcel;

(B) in response to a first request by the first user of the plurality of users to ship the first parcel, calculate, for each respective carrier of a plurality of carriers, a respective carrier-specific dimensional weight of the first parcel according to the first set of parcel specifications for the first parcel, according to a respective set of dimensional weight calculations rules for the respective carrier, and according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel; and

(C) in response to the request by the first user to ship the first parcel:

(1) identify each respective carrier of the plurality of carriers that would support shipping the first parcel according to the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in Step (B), and according to a respective carrier-specific dimensional weight limitation for the respective carrier; and

(2) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the

first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

3. A shipping management computer system, said shipping management computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

(A) receive, via a first remote -user client computer device of a plurality of remote user client computer devices, a first input from a first user associated with the first remote user client computer device, said first input comprising a first set of parcel specifications for a first parcel, wherein the shipping management computer system is operable to associate a first user-specific origin identifier with the first user, wherein the first user accesses the shipping management computer system via a global communications network via the first remote user client computer device, wherein the first remote user client computer device is adapted for communication via the global communications network, and wherein the first set of parcel specifications comprises a first set of physical dimensions of the first parcel and a first physical weight of the first parcel; and

(B) in response to a first request by the first user of the plurality of users to ship the first parcel, for each respective carrier of a plurality of carriers:

(1) calculate a respective carrier-specific dimensional weight for the first parcel according to the first set of parcel specifications and according to a respective set of dimensional weight calculation rules for the respective carrier, wherein each respective carrier-specific dimensional weight is calculated according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel;

(2) determine whether the respective carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier; and

(3) in response to determining that the respective carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding respective carrier-specific dimensional weight limitation for the respective carrier, designate the respective carrier as a respective supporting carrier for shipping the first parcel.

4. The shipping management computer system of Claim 3, said shipping management computer system further programmed to:

(C) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected, according to the respective set of carrier-

specific billable weight rules, from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

5. The shipping management computer system of Claim 4, said shipping management computer system further programmed to:

(D) for each respective delivery service of a plurality of delivery services offered by each respective supporting carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel.

6. The shipping management computer system of Claim 5, said shipping management computer system further programmed to:

(E) receive, via a second remote user client computer device of the plurality of remote user client computer devices, a second input from a second user associated with the second remote user client computer device of a second set of parcel specifications for a second parcel, wherein the shipping management computer system is operable to associate a second user-specific origin identifier with the second user, wherein the second user accesses the shipping management computer system via the global communications network via the second remote-user client computer device, wherein the second remote user client computer device is adapted for communication via the global communications network, and wherein the second set of parcel

specifications comprises a second set of physical dimensions of the second parcel and a second physical weight of the second parcel; and

(F) in response to a second request by the second user of the plurality of users to ship the second parcel, for each respective carrier of a plurality of carriers:

(1) calculate a respective carrier-specific dimensional weight of the second parcel according to the second set of parcel specifications, according to a respective set of dimensional weight calculation rules for the respective carrier, and according to the second set of physical dimensions of the second parcel in view of the second physical weight of the second parcel;

(2) determine whether the respective carrier-specific dimensional weight of the second parcel calculated in Step (F)(1) for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier; and

(3) in response to determining that the respective carrier specific dimensional weight of the second parcel calculated in Step (F)(1) does not exceed the corresponding respective carrier-specific dimensional weight limitation for the respective carrier, designate the respective carrier as a respective supporting carrier.

7. The shipping management computer system of Claim 5, said shipping management computer system further programmed to:

(E) generate an online comparison display of the respective service-specific, carrier-specific shipping rates for shipping the first parcel to a first display monitor

configured with the first remote user client computer device of the particular respective user.

58. A method, using a computer system, for managing shipping of a plurality of parcels shipped by any one of a plurality of carriers, the method comprising:

(A) receiving, via a first remote user client computer device of a plurality of remote user client computer devices, a first input, said first input comprising a first set of parcel specifications for a first parcel to be shipped by a first user, wherein the first set of parcel specifications comprises a first set of physical specifications about the first parcel, and wherein the first set of physical specifications about the first parcel is selected from a group consisting of:

(1) a first set of physical dimensions of the first parcel and a first physical weight of the first parcel, and

(2) a first type of parcel and the first physical weight of the first parcel; and

(B) in response to the first input, for a first carrier of a plurality of carriers:

(1) calculating a first carrier-specific dimensional weight according to a first set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel; and

(2) determining a first carrier-specific billable weight of the first parcel for the first carrier, wherein the first carrier-specific billable weight of the first parcel for the first carrier is selected, according to a first set of carrier-specific billable weight rules, from a group consisting of: the physical weight of the first parcel, the first carrier-specific dimensional weight of the first parcel for the first carrier

calculated in Step (B)(1), a first carrier-specific oversize weight of the first parcel, and a first carrier-specific letter weight.

59. The method of Claim 58, said method further comprising:

(C) in response to the first input, for a second carrier of the plurality of carriers:

(1) calculating a second carrier-specific dimensional weight according to a second set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel; and

(2) determining a second carrier-specific billable weight of the first parcel for the second carrier, wherein the second carrier-specific billable weight of the first parcel for the second carrier is selected, according to a second set of carrier-specific billable weight rules, from a group consisting of: the physical weight of the first parcel, the second carrier-specific dimensional weight of the first parcel for the second carrier calculated in Step (C)(1), a second carrier-specific oversize weight of the first parcel, and a second carrier-specific letter weight.

60. The method of Claim 58, said method further comprising:

(C) determining whether the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the first carrier exceeds a corresponding first carrier-specific dimensional weight limitation for the first carrier; and

(D) in response to determining that the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding first carrier-

specific dimensional weight limitation for the first carrier, designating the first carrier as a first supporting carrier for shipping the first parcel.

61. The method of Claim 59, said method further comprising:

(D) determining whether the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the first carrier exceeds a corresponding first carrier-specific dimensional weight limitation for the first carrier;

(E) in response to determining that the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding first carrier-specific dimensional weight limitation for the first carrier, designating the first carrier as a first supporting carrier for shipping the first parcel;

(F) determining whether the second carrier-specific dimensional weight of the first parcel calculated in Step (C)(1) for the second carrier exceeds a corresponding second carrier-specific dimensional weight limitation for the second carrier; and

(G) in response to determining that the second carrier-specific dimensional weight of the first parcel calculated in Step (C)(1) does not exceed the corresponding second carrier-specific dimensional weight limitation for the second carrier, designating the second carrier as a second supporting carrier for shipping the first parcel.

62. The method of Claim 58, wherein the first carrier-specific billable weight of the first parcel for the first carrier is the physical weight of the first parcel.

66. The method of Claim 59, wherein the second carrier-specific billable weight of the first parcel for the second carrier is the physical weight of the first parcel.

70. The method of Claim 58, said method further comprising:

(C) determining whether the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the first carrier exceeds a corresponding first carrier-specific dimensional weight limitation for the first carrier; and

(D) in response to determining that the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding first carrier-specific dimensional weight limitation for the first carrier, for each respective delivery service of a plurality of delivery services offered by the first carrier: calculating a respective service-specific shipping rate for shipping the first parcel.

71. The method of Claim 70, said method further comprising

(E) generating an online comparison display of each respective service-specific shipping rate for shipping the first parcel calculated in Step (D) to a first display monitor operable with the first remote user client computer device.

72. The method of Claim 59, said method further comprising:

(D) determining whether the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the first carrier exceeds a corresponding first carrier-specific dimensional weight limitation for the first carrier;

(E) in response to determining that the first carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding first carrier-specific dimensional weight limitation for the first carrier, for each respective delivery service of a plurality of delivery services offered by the first carrier, calculating a first respective service-specific shipping rate for shipping the first parcel;

(F) determining whether the second carrier-specific dimensional weight of the first parcel calculated in Step (C)(1) for the second carrier exceeds a corresponding second carrier-specific dimensional weight limitation for the second carrier; and

(G) in response to determining that the second carrier-specific dimensional weight of the first parcel calculated in Step (C)(1) does not exceed the corresponding second carrier-specific dimensional weight limitation for the second carrier, for each respective delivery service of a plurality of delivery services offered by the second carrier, calculating a second respective service-specific shipping rate for shipping the first parcel.

73. The method of Claim 72, said method further comprising:

(H) generating an online comparison display to a first display monitor operable with the first remote user client computer device, wherein said online comparison display comprises an indication of each first respective service-specific shipping rate for shipping the first parcel calculated in Step (E) and an indication of each second respective service-specific shipping rate for shipping the first parcel calculated in Step (G).

74. The shipping management computer system of Claim 1, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is the physical weight of the first parcel.

78. The shipping management computer system of Claim 1, said shipping management computer system further programmed to:

(C) identify each respective carrier of the plurality of carriers that would support shipping the first parcel according to the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in Step (B)(1), and according to a respective carrier-specific dimensional weight limitation for the respective carrier;

(D)) for each respective carrier that would support shipping the first parcel, for each respective delivery service of a plurality of delivery services offered by the respective carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel using the respective carrier-specific billable weight determined for the respective carrier in Step (B)(2); and

(E) generate an online comparison display to a first display monitor operable with the first remote user client computer device, wherein said online comparison display comprises an indication of each respective service-specific shipping rate for shipping the first parcel calculated in Step (D).

79. The shipping management computer system of Claim 2, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is the physical weight of the first parcel.

83. The shipping management computer system of Claim 2, said shipping management computer system further programmed to:

(D) for each respective carrier identified in Step (C)(1) that would support shipping the first parcel, for each respective delivery service of a plurality of delivery services offered by the respective carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel using the respective carrier-specific billable weight determined for the respective carrier in Step (C)(2); and

(E) generate an online comparison display to a first display monitor operable with the first remote user client computer device, wherein said online comparison display comprises an indication of each respective service-specific shipping rate for shipping the first parcel calculated in Step (D).

EVIDENCE APPENDIX (37 C.F.R. §41.37(c)(1)(ix) heading)

A copy of Kara (U.S. Patent No. 6,233,568; "Kara") as relied on in the final Office Action dated March 13, 2006 is attached hereto.

A copy of Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") as relied on in the final Office Action dated March 13, 2006 is attached hereto.

A copy of Barns-Slavin et al. (U.S. Patent No. 5,995,950; "Barns-Slavin") as relied on in the final Office Action dated March 13, 2006 is attached hereto.

A copy of Jensen (U.S. Patent No. 5,331,118; "Jensen") as relied on in the final Office Action dated March 13, 2006 is attached hereto.

RELATED PROCEEDINGS APPENDIX (37 C.F.R. §41.37(c)(1)(xi) heading)

1. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating Application No. 09/684,861 remains on appeal, is attached hereto.
2. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating Application No. 09/680,654 remains on appeal, is attached hereto.
3. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review, dated July 21, 2006, indicating the present application (Application No. 09/685,077) remains on appeal, is attached hereto.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/684,861

10/06/2000

Paul Bilibin

PSTM0024/MRK

2827

29524

7590

04/18/2006

KHORSANDI PATENT LAW GROUP, A.L.C.

140 S. LAKE., SUITE 312

PASADENA, CA 91101-4710

EXAMINER

VAN DOREN, BETH


ART UNIT

PAPER NUMBER

3623

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Number 	Application/Control No. 09/684,861	Applicant(s)/Patent under Reexamination BILIBIN ET AL.	
	Beth Van Doren	Art Unit 3623	
Document Code - AP.PRE.DEC			

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 3/20/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1-13 & 15-17 & 19-23
 Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Beth Van Doren *BVD*
 (2) Susanna Diaz *SD*

(3) Tariq Hafiz *TH*
 (4) _____



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,654	10/06/2000	David Allison Bennett	PSTM0015/MRK	9943

29524 7590 05/19/2006

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER


WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application Numb 	Application/Control No. 09/680,654 John G. Weiss	Applicant(s)/Patent under Re. mination BENNETT ET AL. Art Unit 3629
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 5/2/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-21, 26-52 and 57-70.

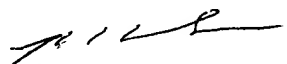
Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn, and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

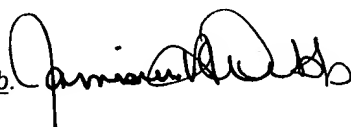
4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) John G. Weiss



(3) Jami Webb



(2) Dean Nguyen



(4) _____



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilibin	PSTM0020/MRK/STM	3148
29524	7590	07/21/2006	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C.			WEBB, JAMISUE A	
140 S. LAKE., SUITE 312			ART UNIT	
PASADENA, CA 91101-4710			PAPER NUMBER	
			3629	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-155-

Application Number 	Application/Control No. 09/685,077 John G. Weiss	Applicant(s)/Patent under Reexamination BILIBIN ET AL. Art Unit 3629	
Document Code - AP.PRE.DEC			

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 6/15/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7, 58-83.

Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) John G. Weiss

(2) Dean Nguyen

(3) Jamisque Webb

(4) _____

US Express Mail No. ED 329501236US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

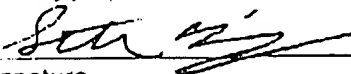
Applicant(s): Paul Bilibin, et al.	Technology Center: 3600
Serial No.: 09/685,077	Group Art Unit: 3629
Filed: October 6, 2000	Examiner: Webb, Jamisue A.
Title: APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT DETERMINATION OF RATABLE WEIGHT FOR MULTIPLE CARRIERS	
Attorney Docket No.: PSTM0020/MRK	

STATEMENT UNDER 37 C.F.R. §3.73(b)

STAMPS.COM INC. is the owner of an undivided whole interest in common with ISHIP INC. in the instant application. Documentary evidence of the chain of title in accordance with 37 C.F.R. 3.73 (b)(1)(ii) is recorded: 1.) in an Assignment of the entire right, title and interest from the Inventors named in the instant application to STAMPS.COM INC. as recorded by the Assignment Division of the United States Patent and Trademark Office on March 13, 2001 on Reel No. 011630 and Frame No. 0272; and 2.) in a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment identifying both STAMPS.COM INC. and ISHIP INC. as Assignees of an undivided whole interest in common in all rights title and interest in and to the instant application as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275.

The undersigned is empowered to act on behalf of STAMPS.COM INC.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Signature

SETH WEISBERG

Typed or printed name

(310) 482-5808
Telephone Number

Aug. 16, 2006
Date

VP + GENERAL COUNSEL
Title

U.S. Express Mail No. ED 32950123645



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Paul Bilibin, et al.	Technology Center: 3600
Serial No.: 09/685,077	Group Art Unit: 3629
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Signature

W T Davis
Typed or printed name

425-602-4848
Telephone Number

8/28/06
Date

Via President
Title